

DOCKET NO.: 292754US0PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Bernfried KALTHOF, et al.

SERIAL NO: 10/585,932

GROUP: 1791

CONFIRMATION NO. 9274

EXAMINER: G. Hauth

FILED: July 13, 2006

FOR: METHOD FOR PRODUCING PLASTIC RODS

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

Sir:

In response to the Restriction Requirement mailed May 7, 2009, Applicants elect, with traverse, Group I, Claims 1-3, for examination.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

The Office is requiring restriction to one of the following groups:

- Group I: Claims 1-3, drawn to a method of making a rod;
- Group II: Claims 5-6, drawn to an apparatus for making a rod;
- Group III: Claim 4, drawn to a rod; and
- Group IV: Claim 7, drawn to a method of using a rod.

Applicants elect, with traverse, Group I, Claims 1-3, for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office alleges that Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: “The common technical features of groups 1-4 is a rod formed by the coextrusion of concentric performs. This technical feature was found to not define over the prior art *a posteriori* in view of Reifenhauser (PN 3229005).”

Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states, emphasis added:

The expression “special technical feature” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, ***considered as a whole***, makes over the prior art. The determination is made on the contents of the claims as ***interpreted in light of the description*** and drawings (if any).

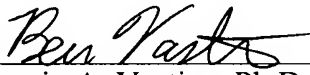
Applicants respectfully submit that the Office did not consider the contribution of each invention, *as a whole*, in alleging the lack of a special technical feature in view of the cited reference. Applicants also respectfully submit that the Office has not provided any indication that the contents of the claims *interpreted in light of the description* were considered in making this allegation. Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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